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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,108	07/24/2003	Brent L. Davis	BOC9-2003-0006 (375)	8969
40987 7590 01/03/2007 AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER GAUTHIER, GERALD	
			ART UNIT	PAPER NUMBER
			2614	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/626,108

**Applicant(s)**

DAVIS ET AL.

**Examiner**

Gerald Gauthier

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,11-13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,11-13 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 1, 2006 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claim(s) 1-3, 5, 6, 11-13 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiswani et al. (US 6,160,995) in view of Hanson et al (US 6,697,474 B1) and in view of Contractor (US 2003/0099334 A1) and further in view of Thomson et al. (US 6,487,533 B2).

Regarding **claim(s) 1 and 16**, Kiswani discloses a method to enable instant collaboration via the use of pervasive messaging (FIG. 1 and column 1, lines 6-9), comprising the steps of:

receiving a call from a caller to a callee (FIG. 5 and column 4, lines 33-38);

transferring the call to a voicemail system when the callee is unavailable (column 4, lines 40-46); and

querying the caller if they want to leave one among a voice message and an instant message (column 4, lines 48-53).

Kiswani discloses prompting the caller for a text message but fails to disclose determining if the callee is available via instant messaging.

However, Hanson in the same field of endeavor teaches determining if the callee is available via instant messaging (FIGS. 7-9 and column 8, lines 57-63) [The ACP 125 queries the database to determine if the user is currently on line for an instant messaging service].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Kiswani using the teaching automated call processor as taught by Hanson.

This modification of the invention enables the system to determine if the callee is available via instant messaging so that the user would receive a telephone call via its instant messaging client.

Kiswani as modified fails to disclose generating a text message by transcribing the voice message.

However, Contractor teaches recording a voice message from the caller to the callee and generating a text message by transcribing the voice message if the caller elects the option of leaving the instant message, the text message subsequently being delivered to the callee (paragraphs 0031).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Kiswani using the teaching of instant messaging platform as taught by Contractor.

This modification of the invention enables the system to generate a text message by transcribing the voice message so that the user would receive a text instant message via its instant messaging client.

Kiswani as modified fails to disclose determine a preferred language of the callee.

However, Hyde-Thomson teaches determine a preferred language of the callee and translate the text message into the preferred language of the callee if the preferred language of the callee is different from a language of the transcribed message (column 8, lines 45-62).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Kiswani using the teaching of translating a message as taught by Hyde-Thomson.

This modification of the invention enables the system to determine a preferred language of the callee so that the user would receive a text instant message via its instant messaging client in e preferred language.

Regarding **claim(s) 2**, Hanson teaches a method wherein the method further comprises querying a caller who elects to leave voice message to determine whether the caller wants to also leave an instant message for the callee, wherein the instant message is delivered at a predetermined schedule time dictated by the caller (column 8, lines 55-63).

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Regarding **claim(s) 3**, Hanson teaches a method, wherein the method further comprises the step of sending the text message to the callee via the instant messaging system (column 8, lines 55-63).

Regarding **claim(s) 4**, Hanson teaches a method, wherein the method further comprises the step of translating the text message to provide a translated text message and sending the translated text message to the callee via the instant messaging system (column 8, lines 55-63).

Regarding **claim(s) 5**, Hanson teaches a method, wherein the method further comprises the step of querying the caller as to when an instant message should be delivered when the caller selected the instant message as an option (column 8, lines 55-63).

Regarding **claim(s) 6 and 12**, Hanson teaches a method, wherein the method further comprises the step of delivering the instant message to the callee at a predetermined scheduled time as directed by the caller (column 9, lines 28-42).

Regarding **claim(s) 11**, Kiswani in combination with Hanson, Contractor and Hyde-Thomson disclose all the limitations of **claim(s) 11** as stated in **claim(s) 1's** rejection and furthermore Kiswani discloses a voicemail system (330 on FIG. 3);

an instant messaging system coupled to the voicemail system (330 on FIG. 3);  
and a processor (330 on FIG. 3).

Regarding **claim(s) 13**, Kiswani discloses a system wherein the processor resides within the voicemail system (330 on FIG. 3).

### ***Response to Arguments***

6. Applicant's arguments with respect to **claim(s) 1-6, 11-13 and 16** have been considered but are moot in view of the new ground(s) of rejection.


### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Gerald Gauthier  
Primary Examiner  
Art Unit 2614

GG  
December 20, 2006